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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/520,111
Filing Date: January 03, 2005
Appellant(s): BERN ET AL.

Jeffrey S. Melcher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/13/07 appealing from the Office action mailed 6/27/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Sawano et al., US 2001/0039212 A1 and Itou et al. U.S. Patent 6,354,940 are relied upon as evidence in the rejections of the claims.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 18, 21-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawano et al., US 2001/0039212 A1.

Sawano et al. disclose a handheld game console (12) in an electronic card game system (Figure 1 and 10) comprising a battery power supply (Paragraph 0059, line 5), a display (24), a processor (66), a memory (70, 72), an electronic card reader and writer

(68), a receiving opening (38), a wired/wireless communication port (16) and a controller (26).

The electronic game card (40), in a system as described above, able to be inserted (Figure 1) comprising a memory comprising changeable data (76) where when the card is inserted it is read (Figure 12B; S51) and where it receives at least one new value (Paragraph 0059, back-up data).

The processor being configured for reading (Figure 12B, S51) first data (Figure 12B; Demo screen program in cartridge) from the electronic game card; receiving a second data from a second game console using the communication means (Figure 12; S53, negotiating), the second data comprising at least one game related attribute and at least one value (Paragraph 0104; transfer request command); generating a game result (Figure 12A; S56, using the transfer command to determine if the data is transferred and continuing in the flow chart); writing to the memory of the electronic game card (Paragraph 0059; back-up data); transmitting data (Figure 12; Synchronization) and displaying a first data (Figure 13; Demo screen).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawano et al., in view of Itou et al. U.S. Patent 6,354,940.

Sawano et al disclose a game system where individual games are loaded on to electronic game cards. Sawano et al. also disclose that a possible type of game being used by the system is a battle type game (Figure 12B, S55). Itou et al. disclose a battle type game stored on a computer readable medium where the game result is based on a random function (Col. 9, lines 9-13) and where at least one new value is decreased (Col. 5, line 65 – Col 6. line 8). It would have been obvious at the time the invention was made to modify Sawano et al.'s game console to decrease at least one new value as taught by Itou et al. in order to increase the level of interest of a player in a battle type game.

(10) Response to Argument

Appellant's arguments with respect to claims 17-18 and 21-23 have been considered but are not persuasive because they are not in commensurate scope with the claims. While the argument is made that Sawano discloses source code being transferred and appellant's invention relates to source code being executed, the claim language of claims 17-24 and 26 recites merely a game console with "a processor being configured for..." and does not recite the execution of any program, steps or code of any kind. Sawano discloses a game console with a processor that is configured for, and capable of, performing the steps recited in the claims as presented.

Appellant's argument that generating a game result is patentably distinct and not disclosed by Sawano is not found to be persuasive. Appellant argues that a game result is more than a yes/no, 1/0 result as disclosed by Sawano. Applicant does admit however that a game result can be 0, amongst other results (Page 6, paragraph 5, line 5 of Appellant's Appeal brief). Sawano, by applicants admission, therefore discloses a game result from a sub-set of appellants game results. While Sawano might not disclose generating a game result that can fall in as broad a range as appellants invention, he does disclose a game result within the range of appellant's claimed invention and therefore properly anticipates the claims.

Appellant's argument that Sawano does not disclose a cartridge in each console is not in commensurate scope with the claims. Nowhere in claims 17-18 and 21-23 is there a limitation for more than one cartridge. Claim 17 recites, "reading a first data item from **an** electronic game card" and, "receiving a second data item from a second game console". Sawano discloses **a** game cartridge providing data from a first or master game console and data provided by a second game console, as cited in the previous rejections. Sawano therefore properly anticipates the claimed invention of claim 17 with regards to the amount of recited game cartridges required.

Appellant's arguments with respect to claim 24 are not found to be persuasive. Appellant asserts that no language from Sawano was cited to explicitly point out where the data contained on the game cartridge included a "game related attribute and at least one value associated thereto". Examiner cited paragraph 0059, explicitly the back-up of information, in paragraph number 3 on page 2 of the final office action, with regards to

the type of data contained on the game cartridge. It is obvious to any one of ordinary skill in the art that back-up data of a game on a game cartridge, as cited by the examiner, contains game attributes, values and information pertinent to the progress of the game it is backing up. Again, appellant's argument that Sawano does not disclose a game cartridge in each game console is not in commensurate scope with the claims for the same reasons as discussed in the paragraph above.

Appellant's arguments with respect to claim 26 are not found to be persuasive. While claim 26 differs from the previous claims discussed above in that it **does** claim at least 2 game cartridges, it still does not claim a cartridge in each of the game consoles. Merely what is claimed is a system as discussed above with an additional cartridge that can be swapped with the first. Sawano discloses the cartridge being removable as is claimed in claim 26. While Sawano does not explicitly disclose the presence of multiple game cartridges, it is inherent in the disclosure that if you have a removable game cartridge, the only purpose for it being removable is so that a user can place different cartridges in the system. If this were not the case, then it would be pointless to have a removable cartridge. Sawano discloses a system with a removable game cartridge that meets the claim limitations of claim 26. Since the removable game cartridge disclosed is a general game cartridge and not a specific game cartridge for say a particular pin ball game, it is interpreted that general game cartridge is a representation of a large set of game cartridges usable by the system.

Appellants arguments with regards to claims 19 and 20 are not persuasive since the examiner maintains that Sawano properly anticipated the claims that claim 19 and 20 depend from.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joshua P. Wert

Conferees:

Robert Pezzuto

Eugene Kim